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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,393	04/28/2006	Klaus Worgull	3592	1515
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MICHAEL J. STRIKER 103 EAST NECK ROAD HUNTINGTON, NY 11743				
EXAMINER				
DEFRANK, JOSEPH S				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/563,393

**Applicant(s)**

WORGULL ET AL.

**Examiner**

JOSEPH DEFRANK

**Art Unit**

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to the amendment filed on 6-3-08. Claims 1-13 were canceled and claims 14-24 are pending.

***Drawings***

2. The drawings were received on 6-3-08. These drawings are acceptable.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The phrase "whereby a finely graduated thinning of the hair is attained without strips when the thinning tool is placed..." is confusing. No matter what, a hair clipper of this nature will cut in strips in the sense that there are multiple parallel, spaced blades cutting in the same direction. Examiner notes the terminology is used in the specification, but it is still not clear how this leads to cutting "without strips" when there are multiple "strips" of hair cut during each pass of the tool over a head of hair. Each blade path cuts a strip.
6. With respect to claim 15, the phrase "diameter of an individual hair" is indefinite. The diameter of a strand of hair is not a standard dimension and can vary greatly on the body of one person and can vary to a larger degree between different species of animals.

***Claim Objections***

7. Claim 24 is objected to because of the following informalities: the claim is incomplete. Following the pattern of the prior claims, the claim should end with "tool (1)." Examiner notes that most likely the final page did not get submitted with the amendment. Examiner has received only pages 2-6 of the claims. This remaining portion is found on the amendment to the abstract. Please submit the claims on separate sheets from the abstract amendment.

***Claim Rejections - 35 USC § 102***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claims 14, 19-21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Fewins (US 2,481,097; as previously cited).
10. With respect to claims 14 and 19, Fewins discloses a set of thinning tools (and thus a thinning tool) for an electric hair clipper (A), said electric hair clipper comprising a lower shearing blade (B) with a lower row of teeth and an upper shearing blade (C) with an upper row of teeth, said upper shearing blade (C) being swingable back and forth parallel to said lower row of said teeth (see column 2 lines 21-26); wherein a first thinning tool (figure 1) of said set of said thinning tools comprises two retaining rails (10, 11) on opposite sides thereof, said retaining rails being embodied so that the first thinning tool is placeable on said lower shearing blade (see figure 6); and a row of tines (9) provided with tine slots extending between said tines, said tines being provided on lower ends thereof with stops (18, 19); Examiner notes that though not directly mounted

on the tines, the tines are still provided with the stops as they are all the same singular piece) that abut against a free end of the lower shearing blade when the first thinning tool is placed on the lower shearing blade, so that said tines form an extension of said teeth (see figure 6) of said lower row of teeth of said lower shearing blade; wherein said tine slots are provided with conical enlargements (the front end of the tines are cone shaped and naturally enlarge) at free ends of the tine slots for catching and guiding hairs and said tine slots each have a width at ends of the tine slots that are opposite to the free ends, such that the hairs in each of said tine slots are cut in succession instead of simultaneously (hair is advanced through the slots towards the cutters and thus they are considered to be cut in succession); whereby a finely graduated thinning of the hair is attained without strips when the first thinning tool is placed on the lower shearing blade and the electric hair clipper is operated to thin the hair.

11. With respect to claim 20, Fewins discloses including at least one other thinning tool besides said first thinning tool (see figure 7), said at least one other thinning tool having different hair thinning properties from those of said first thinning tool (it cuts hair faster; column 4, lines 20-28).

12. With respect to claim 21, Fewins discloses the set of thinning tools wherein said at least one other thinning tool (figure 7) is a further thinning tool and said further thinning tool has a row of tines provided with tine slots extending between said tines, said tines being provided on lower ends thereof with stops that abut against a free end of the lower shearing blade when said further thinning tool is placed on the lower shearing blade, so that said tines form an extension of said teeth of said lower row of

teeth of said lower shearing blade (examiner notes this is the same structure as the first thinning tool); and wherein said tine slots of said further thinning tool have widths that are equal to each other, but different from said width of said tine slots of said first thinning tool. The second thinning tool has a "skip-tooth" arrangement resulting in larger tine slots.

13. With respect to claim 23, Fewins discloses the set of thinning tools wherein said another thinning tool has a different number of said tines (it will have half in the skip-tooth arrangement) than said first thinning tool so that a spacing of said tines in said another thinning tool differs from a spacing of said tines in said first thinning tool.

***Claim Rejections - 35 USC § 103***

14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 16-18, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fewins.

16. With respect to claims 16-18, Fewins discloses the thinning tool of claim 14. Fewins, however, does not specifically disclose the dimensions pertaining to the tine slots of the thinning tool. Examiner notes that all these dimensions are related to the intended use of the thinning tool attachment. If the attachment is intended to be used on small mammals (i.e. mice) the width of the hair and thickness of the hair will vary greatly than if the thinning tool attachment is intended to be used on an elephant. Regardless, Fewins does not disclose the tine slot width to be equal to 0.2mm or the tine spacing to be equal to 4mm (between 3 and 8mm). However, it is noted that Fewins

does disclose that the teeth can be spaced out in any manner which provides the desired hair cutting characteristics (column 2 line 45 through column 3 line 2). Further, as demonstrated by Fewins, increasing the gap increases the quickness of the cut (see column 4 lines 20-28); quickness is a cutting characteristic.

With respect to each dimension, examiner also notes that there is a very limited range of dimensions the can be applied to combs for electric hair clippers. The comb can only be as wide as the clipper and provide a tine slot width no more narrow than the width of a single hair. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the comb of Fewins in order to provide a tine slot width of approximately 0.2mm, a conical enlargement height of approximately 3mm, and/or a tine spacing of approximately 4mm since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Examiner notes that the aforementioned limitations would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that the product is not of innovation but of ordinary skill and common sense.

17. With respect to claim 22, Fewins does not explicitly disclose the set of thinning tools wherein said equal widths of said tine slots of said second thinning tool each is in a range of from 0.5 to 1.0 mm. Examiner notes (as above) that this limitation is largely dependent on the intended use of the thinning tool as well as the overall scale of the tool. Further, it is noted that there is a very limited range of dimensions the can be

applied to combs for electric hair clippers. The comb can only be as wide as the clipper and provide a tine slot width no more narrow than the width of a single hair. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the comb of Fewins in order to provide a tine slot width of 0.5 to 1.0mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Examiner notes that the aforementioned limitations would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that the product is not of innovation but of ordinary skill and common sense.

18. With respect to claim 24, Fewins discloses the set of thinning tools for an electric hair clipper wherein said at least one other thinning tool is an additional thinning tool and said additional thinning tool has a row of tines provided with tine slots extending between said tines, said tines being provided on lower ends thereof with stops that abut against a free end of the lower shearing blade when the additional thinning tool is placed on the lower shearing blade, so that said tines form an extension of said teeth of said lower row of teeth of said lower shearing blade (as noted above the second cutting guide has the same setup as the first). Fewins does not disclose wherein said tine slots of said additional thinning tool have widths and that are not equal to each other and that alternate in a direction from one side of the additional thinning tool to the other and said widths and are different from said width of said tine slots of said first thinning tool. It would have been an obvious matter of design choice to make the different portions of



the guard of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. In re Dailey et al., 149 USPQ 47. Thus, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide different guards having tine slots with any width configuration regardless of what the other guards have in order to achieve a specific thinning characteristic.

19. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fewins in view of Adachi (US 6,526,662).

Fewins does not disclose the thinning tool for the electric hair clipper wherein said width of each of said tine slots is equal to a diameter of an individual strand of hair. Examiner notes that this is a statement of intended use. Hairs vary greatly in diameters. Within a single human body, the hair's diameter ranges from thin soft hair to thicker coarser hair. Outside of humans (mammals have hair), the hair of an elephant, for example, can be thick enough to use a single hair to make bracelets out of.

Adachi discloses a pair of shears having guide slits of a width (W) approximately equal to that of the target hair (X). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. In this case, modifying the width of the tine slots to be equal to a targeted hair width is well known in the art. This technique is used to effectively prevent hair slippage

(column 1 line 63). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the tine slots of Fewins to have a width equal to that of a target hair to be cut in view of the teachings of Adachi in order to prevent hair slippage while cutting.

### ***Response to Arguments***

20. In the interview with Mr. Valance on June 24th, 2008, Examiner notes that it was indicated that the new claims appeared to overcome the previous rejections. However, after further consideration of the changes to the claimed limitations, have not overcome the previous art rejections. Explanations with respect to each contention are addressed below.

21. Applicant's arguments filed have been fully considered but they are not persuasive. Applicant argues that the thinning tools of Fewins are different in their structure and features from the thinning tool of the new claim.

22. Applicant argues that the thinning tools of Fewins does not disclose stops at the bottom ends of their tines that abut against the free end of the lower shearing blade. Examiner notes that the hair thinning tools of Fewins do have stops at the bottom ends of their tines. The stops (18, 19) are located beneath the tine slots (with respect to the open end of the tine slots) and are considered to be stops provided on the lower ends of the tines, just as the claim language calls for. Examiner notes that the thinning tool is all one piece and the stops are indeed provided on the lower ends of the tines.

23. Applicant argues that the tines of Fewins are not extensions of the teeth of the lower shearing blade. Applicant has cited column 2 lines 34-45 of Fewins as evidence

of this. The cited portion does disclose the tines being an extension of the teeth. In fact, the tines "protrude a short distance beyond the tips of the teeth" clearly portraying the tines as extensions of the teeth as they extend beyond the teeth.

24. Applicant argues that the tine slot widths are not capable of having individual hairs cut in succession. Examiner points out that this is a statement of intended use. The thinning tool of Fewins is perfectly capable of allowing hairs to be cut in succession as claimed. The thickness of the hair being cut is the variable here, and as pointed out in the above rejection, thickness of hair varies greatly. If the hair to be cut is equal to (or just less) than the width of the tine slot, the hairs will be cut in succession. Further, the claim language calls for "the hairs in each of said tine slots are cut in succession instead of simultaneously." Since the tines are indeed extensions of the teeth, it is inevitable that, during use, some hair will exist in the tine slot without also being in the path of the shearing blades. In this case, during the progression of cutting, some hair is initially cut, while other hair isn't, but while advancing the tool, the hair that wasn't cut is then cut while new hair enters the tine slot which isn't cut. This setup has hair cut in succession.

25. Applicant argues that there is no connection made between the desired hair cutting characteristics and the selected spacing of the teeth or tines of the thinning tool, let alone manipulating them "to obtain optimum results" (what is an optimum result?). Further, applicant points out that the tool of Fewins results "to a disadvantageously strip-like haircut or thinning of the hair."

Examiner points out that Fewins indeed does disclose that spacing of the teeth (the slot width) directly correlates with the speed of the cut (column 4 lines20-28). The

speed of a cut is a cutting characteristic. One would not go into a barber and ask for his or her entire head of hair to be cut one individual strand at a time as this would take an abnormal amount of time. On the flip side, it is unreasonable to expect a good haircut to be performed in 30 seconds. It should be well understood from the specification (as well as common sense or by one of ordinary skill in the art) that a slower tool (i.e. one with smaller tine slots) gives the hair stylist more time to style. Just as a faster tool allows a stylist to make quick cuts over large areas (if blade angle or cut lines are not as important). Each set of tine widths allows for a different hair cutting characteristic which can be used together to achieve an optimum cut. Further, the fact that one tool gives a strip-like cut on one set of hair does not mean it will give a strip-like cut on another set of hair. This limitation is fully reliant on the diameter of the hair being cut. Examiner further points out that when cutting small diameter hair, no matter what is done, the hair will be cut in a perceived strip like manner as not only is the shearing tool as a whole a limited width, but the individual sets of cutting teeth are also spaced apart. This results in "strips" from the cutting teeth as well as "strips" from overlaying the shearing tool as a whole.

### ***Conclusion***

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH DEFRANK whose telephone number is (571)270-3512. The examiner can normally be reached on Monday - Thursday; 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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